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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92060197
Party	Defendant Live Eyewear, Inc.
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Submission	Motion to Suspend for Civil Action
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Attachments	2014.11.18 Respondent's Motion to Suspend Proceedings.pdf(17837 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

HORISUN FULFILLMENT, LLC

Petitioner,

v.

LIVE EYEWEAR, INC.

Registrant.

Mark: HORIZON

Registration No.: 4,009,970

Petition No.: 92060197

MOTION TO SUSPEND CANCELLATION PROCEEDING IN VIEW OF PENDING CIVIL
ACTION PURSUANT TO TRADEMARK RULE 2.117(a)

Live Eyewear, Inc. (“Registrant” or “Live Eyewear”), by and through its undersigned counsel, hereby moves pursuant to Trademark Rule 2.117(a), to suspend the above-captioned cancellation proceeding pending the termination of a parallel federal court civil action.

INTRODUCTION

On August 12, 2014 Live Eyewear filed a complaint commencing the case *Live Eyewear, Inc. v. Horisun Fulfillment, LLC*, Case No. CV14-6320 (RGK-CWx) (the “Civil Action”) against Horisun Fulfillment, LLC (“Petitioner”) in the Central District of California for infringement and dilution of Live Eyewear’s registered trademark HORIZON, registration number 4,009,970 (the “’970 Mark”), among other claims arising out of the same transaction and events. The complaint filed in that action (the “Complaint”) alleges that Petitioner’s use of the term “Horisun” in connection with the sale of sunglasses, eyeglasses, or other related merchandise is confusingly similar to Live Eyewear’s ‘970 Mark and that Petitioner’s use of such term, in such a manner, constitutes infringement, false designation of origin and host of other claims that Petitioner’s

actions are in violation of the Lanham Act and California Business and Professions codes. The Complaint seeks a preliminary and permanent injunction as well as monetary damages from Petitioner.

In support of this motion, Live Eyewear submits herewith as Exhibit A a true and correct copy of the Complaint for 1) Trademark Infringement in Violation of Lanham Act § 32; 2) False Designation of Origin in Violation of Lanham Act § 43; 3) Trademark Dilution in Violation of Lanham Act § 43; 4) Cyberpiracy in Violation of Lanham Act § 43; 5) Trademark Infringement in Violation of California Bus. & Prof. Code § 14200 et seq.; 6) Trademark Dilution in Violation of California Bus. & Prof. Code § 14330; 7) Unfair Competition in Violation of California Bus. & Prof. Code § 17200 et seq.; and 8) Common Law Unfair Competition.

On or about October 1, 2013 Live Eyewear caused Petitioner to be served with the Complaint, summons, and other necessary documents. Petitioner answered Live Eyewear's Complaint on or about October 20, 2014, four days after submitting this petition. In its Answer (attached hereto as Exhibit B), Petitioner asserted defenses identical to those it asserted in its Petition to Cancel, namely that the '970 Mark is "invalid and/or unenforceable for reasons set forth in Horisun's Petition to Cancel U.S. Trademark Registration No. 4,009,970 that is currently pending in the U.S. Patent and Trademark Office." See Exhibit B, Petitioner's Answer to Complaint at p. 8:22-26.

The Central District of California has set a scheduling conference for February 9, 2015. Attached hereto as Exhibit C is a true and correct copy of the District Court's order setting the February Scheduling Conference.

GROUND FORS SUSPENSION

Here, suspension of the cancellation proceeding until termination of the civil litigation, that was pending before Petitioner filed this Petition for Cancellation, is the best course of action as the issues Petitioner brings before this Board are already pending in the District Court. Indeed, determination of the issues presented to the District Court both by Live Eyewear and Petitioner will be dispositive of the issues involved in this proceeding.

In Petitioner's Petition to Cancel, Petitioner claims that it has been and will continue to be damaged by the '970 Mark because Live Eyewear has taken steps to enforce the '970 Mark against Petitioner, including seeking monetary damages for Petitioner's infringement as well as a permanent injunction from Petitioner's use and/or future use of the '970 Mark in connection with the sale of sunglasses or other related products as so requested in Live Eyewear's Complaint. Petitioner therefore seeks cancellation on theories of invalidity and unenforceability related to the prosecution of the '970 Mark and Live Eyewear's other enforcement efforts.

However, Live Eyewear already injected the validity of the '970 Mark into the Civil Action when it filed the Complaint attempting to enforce the '970 Mark against Petitioner. Indeed, Petitioner's Answer to the Complaint sets out as its very first affirmative defense invalidity and unenforceability pursuant to the claims made in this proceeding. Thus the precise issues that Petitioner seeks to adjudicate here are already at issue for adjudication in the Civil Action.

Rule 2.117(a) of the Trademark Trial and Appeal Board, codified at 37 C.F.R. § 2,117(a) provides that:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be

suspended until termination of the civil action or other Board proceeding.

The TTAB regularly suspends its proceedings until related district court actions conclude. *See, e.g., The Other Telephone Co. v. Connecticut Nat'l Telephone Co.*, 181 U.S.P.Q. 125, 126-27 (T.T.A.B. 1974) (opposition proceeding stayed because outcome of subsequently filed district court action would be dispositive of issues in opposition proceedings; *PHC, Inc. v. Pioneer Healthcare, Inc.*, 75 F.3d 75, 78 (1st Cir. 1996) (noting that the TTAB has suspended its proceedings even when the federal court action was filed after the TTAB proceedings began); *Goya Foods, Inc. v. Tropicana Prods., Inc.*, 846 F.2d 848, 850 (2nd Cir. 1988) (same); *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ.2d 1933 (T.T.A.B. 1992) (suspending cancellation proceeding in light of pending federal litigation because “[a] review of the complaint in the civil action indicates that a decision by the district court will be dispositive of the issues in this proceeding.”). *See also Tokaido v. Honda Associates Inc.*, 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805 (TTAB 1971); and *Martin Beverage Co. v. Colita Beverage Corp.*, 169 USPQ 568 (TTAB 1971).

In its Answer and Petition to Cancel, Petitioner sets out precisely identical issues: namely whether the ‘970 Mark is valid and enforceable enabling Live Eyewear to enforce it against Petitioner. In what is likely a transparent attempt to avoid federal district court litigation, Petitioner filed this Petition to Cancel only after Live Eyewear’s Complaint was both filed and served on Petitioner. Because the central issues in both the district court action and this cancellation proceeding are the same, and determination of Petitioner’s defenses alleged in the Civil Action will be dispositive of the identical issue in this proceeding, suspension is necessary.

CONCLUSION

In view of the fact that the pending Civil Action involves all the same issues which are involved in this proceeding, the determination of the Civil Action will be dispositive here.

Therefore, pursuant to Trademark Rule 2.117(a), Live Eyewear respectfully requests suspension of this proceeding pending determination of the Civil Action.

Respectfully submitted,

LIVE EYEWEAR, INC.

Dated: November 18, 2014

By: /Nicole M. Norris/

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION PURSUANT TO TRADEMARK RULE 2.117(a) has been served on Petitioner's counsel of record by mailing said copy on November 18, 2014 via First Class Mail, postage prepaid to:

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By: /Nicole M. Norris/
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